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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,675	02/01/2001	Arvin Weiss	56719.000005	3524

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Hunton & Williams  
1900 K Street N.W, Suite 1200  
Washington, DC 20006-1109

EXAMINER
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VARNER, STEVE M

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 01/14/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/774,675

Applicant(s)

WEISS, ARVIN

Examiner

Steve M Varner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/17/03.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 55-61 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

See attached Fig. 15.

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7, 8, 32, 33, 35, 38, 43, 44, 46, 48-50, 53, 54, are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins, Jr.

Regarding claims 1, 43, Hopkins, Jr. shows a plurality of peripheral frame members (A) defining a rectangular frame, a plurality of stud members (B), a first surface covering layer (C) substantially covering a first surface defined by the rectangular frame, and a second surface covering layer (D) substantially covering a second surface defined by the rectangular frame opposite the first surface. Hopkins discloses party wall elements securely fastened (Col. 6, Line 60). It is inherent that there would be fasteners. Hopkins shows the panels as walls (E), roofs (F), or floors (G). (Fig. 15) Hopkins, Jr. shows a building configuration defining placement and attachment of the plurality of wall panels and the plurality of roof panels.

Hopkins, Jr. shows that within the rectangular frame there is one internal connection conduit (138) for a building subsystem preinstalled in the construction panel. (Fig. 16)

Regarding claim 3, Hopkins shows a first portion (L) of the rectangular frame is a lower portion and the second portion (M) of the rectangular frame is an upper portion, whereby the construction panel defines a wall section (Fig. 15).

Regarding claim 4, Hopkins shows the first portion (N) of the rectangular frame is a wall-engaging portion and the second portion (O) is a support-engaging portion, whereby the construction panel defines a roof section (Fig. 15).

Regarding claim 5, Hopkins shows the first portion (L) of the rectangular frame is a support-engaging portion and the second portion (P) is a support-engaging portion, whereby the construction panel defines a floor/ceiling section.

Regarding claim 7, Hopkins shows a door (H). (Fig. 15)

Regarding claim 8, Hopkins shows a surface device (64) and internal connection conduit (135). (Fig. 16)

Regarding claims 32, 33, Hopkins, Jr. shows a first conduit (136) built into a first construction panel or additional construction panels and extending to a first edge of the first construction panel. (Fig. 16) Hopkins, Jr. shows a surface device (143) built into the first construction panel and functionally connected to the first conduit. Hopkins, Jr. shows a source (132) connected to the first conduit at the first edge of the first construction panel. (Fig. 16)

Regarding claim 35, Hopkins, Jr. shows a second conduit (133) within the first construction panel, extending to the first edge of the first construction panel, and functionally connected to the source (132). (Fig. 16)

Regarding claim 38, Hopkins, Jr. shows the first conduit (136) of the first construction panel extending to a second edge of the first construction panel. (Fig. 16)

Regarding claims 44, 46, Hopkins, Jr. shows a frame, insulation (I), an interior surface covering material (J), and a first exterior surface covering material (K). (Fig. 15)

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Regarding claims 48-50, Hopkins, Jr. shows floor and ceiling panels and a bearing ledger (121). (Fig. 15)

Regarding claim 53, Hopkins, Jr. shows a marquee (H). (Fig. 15)

Regarding claim 54, Hopkins, Jr. shows a plurality of modular bays. (Fig. 15)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 9, 10, 12-19, 45, 47, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins, Jr.

Regarding claims 2, 6, Hopkins, Jr. shows the basic claimed structure. Hopkins, Jr. does not show compliance with building standards or sufficient material strength. It would have been an obvious design choice to comply with building standards and have sufficient material strength since this would enable the invention to be erected commercially.

Regarding claim 9, Hopkins, Jr. shows the basic claimed structure. Hopkins, Jr. does not show plates and fasteners. Hopkins is fastened (Col. 6, Line 60). It is inherent that there would be fasteners. Plates are well known in the art. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to employ plates in the connection of the panel to adjacent building structures to bridge the gap between structural elements.

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Regarding claim 10, Hopkins, Jr. shows the basic claimed structures. Hopkins does not disclose the claimed dimensions. These dimensions are an obvious design choice for desired use.

Regarding claims 12-19, the claimed methods are the obvious methods of using Hopkins, Jr.'s apparatus for and method of constructing transporting and erecting a structure of two or more stories comprised of a plurality of prefabricated core modules and panelized room elements. It is obvious to place a construction panel, attach using fasteners, and cover a seam in the construction of a building.

Regarding claim 45, Hopkins, Jr. external walls do not show a second exterior surface covering. It is well known in the art to have a second exterior surface covering. It would have been obvious to one of ordinary skill in the art to put an extra surface covering on the external walls to give added protection.

Regarding claim 47, Hopkins, Jr. shows the basic claimed structure. Hopkins, Jr. does not show compliance with building codes. Compliance with building codes is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to comply with building codes in order to get the structure built.

Claims 20-24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts.

Regarding claim 20, Roberts shows a junction box (54) within the construction panel. (Fig. 1) Roberts does not show a surface device for a wire-based subsystem built into at least one construction panel connected electrically to the junction box. It is

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well known in the art to connect a surface device electrically to the junction box. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to use a surface device electrically connected to the junction box in the structure of Roberts since one would have an electric appliance conveniently located in the construction panel. Roberts show a guide conduit (72) within the construction panel and extending from the junction box to an edge of the construction panel. (Fig. 7)

Roberts shows the construction panel (12) attached to at least one pre-existing structure (28) (Fig. 1).

Regarding claim 21, Roberts shows a sill member (72) engaging the construction panel and a base structure (12) and defining a channel for accommodating at least a portion of the connecting wire. (Fig. 7)

Regarding claim 22, Roberts shows an opening for accessing the junction box. (Fig. 1)

Regarding claim 23, Roberts shows the basic claimed structure. Roberts does not show a switch connected to an electrical fixture. Switches connected to electrical fixtures are well known in the art. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to use a switch connected to an electrical fixture in the structure of Roberts since switches can turn on and off electrical fixtures.

Regarding claim 24, Roberts shows the junction box including an electrical box (54) and a plurality of connecting wires including a source wire and at least one connecting wire. (Fig. 1)

Claim 25-31, is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of Stein.

Roberts shows the basic claimed structure. Roberts does not show the surface device and junction box including a subsystem control hub and a plurality of connecting wires electrically connected to other construction panels. Stein shows a subsystem control hub (2) with a plurality of connecting wires (13) electrically connected to other construction panels (14) from the subsystem control hub with surface devices and junction boxes (12). It would have been obvious to one of ordinary skill in the art to combine Stein with the structure of Roberts to distribute electricity to a large building.

Regarding claims 26-31, the claimed methods are the obvious methods of installing Roberts in view of Stein's reinforced foam block wall. Positioning a panel, fixing the panel in place, running a wire, connecting the wire, attaching a cover, are obvious methods to wire a building.

Claims 36, 37, 39-42, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins, Jr. in view of Stein.

Regarding claims 36, 37, Hopkins, Jr. shows the basic claimed structure. Hopkins, Jr. does not show the source of the mechanical system is an HVAC unit as an outdoor unit with the second conduit functionally connected to the outdoor unit and the first conduit of the first construction panel. Stein shows an outdoor HVAC unit with the



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second conduit functionally connected to the outdoor unit and the first conduit of the first construction panel. (Fig. 7.37) It would have been obvious to one of ordinary skill in the art to use an outside HVAC unit in the structure of Hopkins, Jr. since this would save space in the building.

Regarding claims 39-42, the claimed methods are the obvious methods of installing Hopkins, Jr. modified by Stein's apparatus for and method of constructing, transporting and erecting structure of two or more stories comprised of a plurality of prefabricated core modules and panelized room elements.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins, Jr. in view of Borges.

Hopkins, Jr. shows the basic claimed structure. Hopkins, Jr. does not show a mechanical building subsystem pre-installed. Borges shows a mechanical building subsystem pre-installed. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to use a mechanical building subsystem as in Borges in the structure of Hopkins, Jr. to provide for the mechanical needs of the building.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins, Jr. in view of Roberts.

Hopkins, Jr. shows the basic claim structure. Hopkins, Jr. does not show a wire-based building subsystem. Roberts shows a wire-based building subsystem. It would have been obvious to one of ordinary skill in the art at the time the present invention

was made to have a wire-based building subsystem as in Roberts in the structure of Hopkins, Jr. to provide electricity for lighting.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barenburg reveals a method of installing piping, ducts, and conduits in a prefabricated framed wall for building structure and partition made thereby. Haworth et al. shows a wall panel with prewired power system.

### ***Response to Arguments***

Applicant's arguments filed 9/17/03 have been fully considered but they are not persuasive.

Applicant argues that he cannot determine what is being referred to since Hopkins, Jr. uses numerals instead of letters in referencing the drawings.

Examiner maintains that the letters along with the written descriptions are adequate to determine what is referenced in the drawing. (A letter marked up copy of Fig. 15 was included with the previous action. Apparently, this copy was lost. The current action has a letter marked up copy of Fig. 15).

Applicant argues that Examiner has not found compliance with building standards or a load bearing structure.

Examiner maintains that compliance with building standards is well known in the art. Codes such as BOCA (Building Officials and Code Administrators International) are complied with to produce safe buildings. Furthermore, all buildings are load-bearing structures, which support at least themselves.

Applicant has amended claims 1 and 12 to include at least one fastener.

Hopkins, Jr. teaches fasteners.

Applicant has amended claim 20 to include attachment to at least one pre-existing structure.

Roberts foam blocks are attached to the pre-existing concrete slab.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

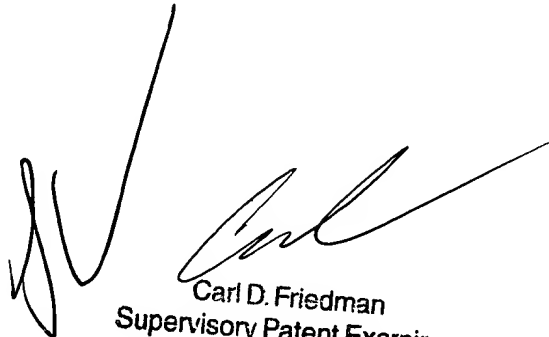
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve M Varner whose telephone number is 703 308-1894. The examiner can normally be reached on M-F 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D Friedman can be reached on 703 308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-7687 for regular communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1113.

SV  
January 5, 2004



Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600

